

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Caffrey et al.
Patent No. : 7,495,013
Issue Date : February 24, 2009
Serial No. : 10/551,493
Filed : September 29, 2005
Title : CHEMICAL COMPOUNDS

Art Unit : 1625
Examiner : Charanjit Aulakh
Conf. No. : 4620

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 530 to 678 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three-year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in *Wyeth et al. v. Jon W. Dudas* (580 F. Supp. 2d 138; 88 USPQ2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. *Id.*

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The *Wyeth v. Dudas* court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: April 21, 2009

Applicant : Caffrey et al.
Patent No. : 7,495,013
Issued : February 24, 2009
Serial No. : 10/551,493
Filed : September 29, 2005
Page : 2 of 4

Attorney's Docket No.: 06275-0471US1 / 101020-1P US

failure of the United States Patent and Trademark Office to issue a patent within 3 years.”
“B delay” begins only after, not before, the PTO has failed to issue a patent within three years.
Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before November 29, 2006 (the date that is fourteen months after September 29, 2005, the date on which the application was filed). The PTO mailed the first non-final Office Action on May 12, 2008, thereby according a PTO Delay of 530 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from November 30, 2006 (the day after the date that is fourteen months after the date on which the application was filed) to May 12, 2008. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 530 days.

“B Delay”

The period beginning on September 30, 2008 (the day after the date that is three years after the date on which the application was filed) and ending February 24, 2009 (the date the patent was issued) is 148 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In view of the period of “B Delay” detailed above, the total “B Delay” for this patent is calculated as a total of 148 days. The PTO calculated 0 days of delay for issuance of a patent

Applicant : Caffrey et al.
Patent No. : 7,495,013
Issued : February 24, 2009
Serial No. : 10/551,493
Filed : September 29, 2005
Page : 3 of 4

Attorney's Docket No.: 06275-0471US1 / 101020-1P US

more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 148 days.

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:
November 30, 2006, to May 12, 2008.

As detailed above, "B Delay" accumulated during the following period:
September 30, 2008, to February 24, 2009.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 530 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 678 days (i.e., the sum of 530 days of "A Delay" and 148 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 0 days; and
- 3) Total PTA should be calculated as 678 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply

Applicant : Caffrey et al.
Patent No. : 7,495,013
Issued : February 24, 2009
Serial No. : 10/551,493
Filed : September 29, 2005
Page : 4 of 4

Attorney's Docket No.: 06275-0471US1 / 101020-1P US

any other required charges to Deposit Account No. 06-1050, referencing Attorney's Docket No. 06275-0471US1.

Respectfully submitted,

Date: April 21, 2009

/Tony Zhang/

Tony Zhang, Ph.D.
Reg. No. L0256

Fish & Richardson P.C.
PTO Customer No. 26164
Telephone: (212) 765-5070
Facsimile: (877) 769-7945

60568437.doc